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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/231,970	09/08/2008	Osamu Moriura	F-9835	5248
28107 7590 11/26/2010 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			EXAMINER MCCLELLAND, KIMBERLY KEIL	
			ART UNIT 1745	PAPER NUMBER
			MAIL DATE 11/26/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

12/231,970

Applicant(s)

MORIURA ET AL.

Examiner

KIMBERLY K. MCCLELLAND

Art Unit

1745

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 12 November 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1, 5-8 and 11-17.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s): 10/12/10
13. ☐ Other: _____.

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1745

/Kimberly K McClelland/
Examiner, Art Unit 1745

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 11/12/10 have been fully considered but they are not persuasive.

With respect to applicant's arguments that the currently recited apparatus claims require a specific function, this argument is not persuasive. Examiner notes claims 1, 5-8, and 11-17 are drawn to an apparatus, not a method. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). The function of the apparatus is not a structural limitation, and therefore constitutes "intended use" of the apparatus, regardless of applicant's statement that such a function is required by the current claim language.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner notes the primary reference, Lang, is relied upon to teach a temporary receiving roller with concave grooves, not Gerlach. In response to applicant's argument that Gerlach does not disclose a temporary receiving roller with concave grooves, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

As to applicant's argument that roller 53 of Gerlach serves as a temporary receiving roller, this argument is not persuasive. Examiner notes roller 57, not 53 is relied upon to transfer the powder particle layer onto the base sheet, not roller 53. One of ordinary skill in the art would look to the powder transfer roller 57 of Gerlach for a teaching of appropriate placement of the temporary receiving roller, not drum 53. Consequently, roller 57 is found to be sufficient to teach placement of a temporary receiving roller, not roller 53. Therefore, this argument is not persuasive.

As to applicant's argument that roller 61 of Gerlach serves as a receiving and transferring roller, this argument is not persuasive. Examiner notes roller 53, not 61 is relied upon to shift the base sheet 64, not roller 61. One of ordinary skill in the art would look to the transport drum 53 of Gerlach for a teaching of appropriate placement of the receiving and transferring roller, not roller 61. Consequently, roller 53 is found to be sufficient to teach placement of a receiving and transferring roller, not roller 61. Therefore, this argument is not persuasive.

Furthermore, Figure 6 of Gerlach illustrates roller 61 performing the function of laminating the cover sheet (60) to the powder layer and the base sheet (64).

Applicant's arguments on pages 11-13 do not address the rejection of record. Instead, applicant provides a different interpretation of secondary reference Gerlach, and argues such an interpretation does not meet the required structural configuration. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

As to applicant's argument that roller 57 of Gerlach is not in contact with drum 53, this argument is not persuasive. The term "adjacent" has a broader meaning than side by side. *Ex parte Appledorn et al.*, 159 USPQ 791. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., rollers in contact) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to applicant's argument that the combination of Gerlach and Lang would only result in uniform application of powder onto roller 53, not base sheet 64, examiner notes Figure 6 clearly illustrates base sheet 64 positioned on the roller face of drum 53, and would therefore exhibit the uniform particle placement at the highest point of the application drum noted by applicant. Consequently, this argument is not persuasive.

With respect to applicant's argument that roller 130 does not temporarily receive powder material, this argument is not persuasive. See Figure 6, which illustrates roller 130 temporarily receiving particle material prior to transferring particle material to roller 140. Therefore, this argument is not found to address the rejection of record.

Applicant's remaining arguments are based on the dependency of claims 5-8 and 11-17 on independent claim 1. These arguments are not persuasive for reasons noted above. Therefore, the rejections of claims 1, 5-8, and 11-17 under 35 U.S.C. 103 (a) over Lang in view of various secondary references is maintained.